

AMENDMENT ACCOMPANYING A REQUEST FOR CONTINUED EXAMINATION

Appln. No. 09/472,666

Amendment dated March 28, 2005

Reply to: Final Office Action of October 28, 2004

Title: METHOD AND MEDIA FOR VIRTUAL PRODUCT PLACEMENT

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1 through 18, 20, 21, and 26 through 32 have been cancelled. Claims 40 through 54 have been withdrawn. No claims have been added. Therefore, claims 19, 22 through 25, 33 through 39, and 55 through 66 remain in this application.

Objection to the Amendment of the Specification

The Patent Office objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, and objected to the previously requested amendment to the specification. The claim that includes the objectionable recitation--namely claim 20--has been cancelled and therefore it is submitted that the objection to the specification is rendered moot. Therefore, Applicant respectfully requests the withdrawal of this objection.

Rejection of the Claims

The Patent Office has rejected claims 19 through 39 and 55 through 56 under 35 U.S.C. 103(a) as obvious over Ebisawa, patent number 5,946,664 (hereinafter "Ebisawa") in view of Margulis 6,456,340 (hereinafter "Margulis").

It was contended in the Advisory Action that:

Ebisawa teaches in Figures 2A-2B, advertisement C is substituted with advertisement D, therefore advertisement C is moved to another

AMENDMENT ACCOMPANYING A REQUEST FOR CONTINUED EXAMINATION

Appln. No. 09/472,666

Amendment dated March 28, 2005

Reply to: Final Office Action of October 28, 2004

Title: METHOD AND MEDIA FOR VIRTUAL PRODUCT PLACEMENT

location when advertisement data is changed C to D. Therefore, the location of advertisement C has been updated or changed.

Although it is not conceded that the Ebisawa patent teaches any change in location of the advertisement, but merely a substitution of an advertisement in the *same* location, it is believed that the use of the term "location" in the claims may be causing some confusion in the respective interpretations of what is required by the claims and whether Ebisawa meets the requirements of the claims. Therefore, some of the language of independent claims 19, 33, 55, 56 and 66 has been amended.

Claim 19 requires, in part, "wherein the communication assembly allows the virtual product source to place the virtual product in the virtual product location of the removable moving media through utilization of the removable content disposed within the source content" and "wherein the communication assembly allows the virtual product source to *update a position of the virtual product location within the removable moving media*" (emphasis added). Similarly, but not identically, claim 33 requires "a virtual product disposed within the virtual product source, the virtual product being a commercial item enabled for placement in the virtual product location of the removable content *in an updated position* for the virtual product location of the removable content" and "wherein the virtual product is downloaded from the network, and placed in the moving media, and *a position of the virtual product location is updated on the moving media*" (all emphasis added). Further, claims 55 and 56 each require "wherein the communication assembly allows the virtual product source to place the virtual product in the virtual product location of the motion picture through utilization of the removable content disposed within the source content" and "wherein the communication assembly allows the virtual product source to *update a position of the virtual product location within the motion picture*" (all emphasis added). Claim 66 requires

AMENDMENT ACCOMPANYING A REQUEST FOR CONTINUED EXAMINATION

Appln. No. 09/472,666

Amendment dated March 28, 2005

Reply to: Final Office Action of October 28, 2004

Title: METHOD AND MEDIA FOR VIRTUAL PRODUCT PLACEMENT

“wherein the communication assembly allows the virtual product source to place the virtual product in the virtual product location of the removable moving media, via an instantiation of the virtual product, through utilization of the removable content disposed within the source content” and “wherein the communication assembly allows the virtual product source to update a position of the virtual product location within the removable moving media”. This aspect is discussed in the specification of the present patent application at, for example, lines 2 through 5 of page 7.

Returning to the rejections set forth in the final Office Action, it is contended in the rejection that:

Ebisawa also teaches the visual product source is at least one of a network and a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text; the virtual product source updates the visual product location on the removable content within the source content (col. 5, lines 35-50)' . . .

Thus, the rejection relies upon the disclosure of the Ebisawa at col. 5, lines 35 through 50 to show the claimed limitations set forth above. Examining the disclosure of Ebisawa closer, it states at col. 5, lines 35 through 50, that:

In either case, commercial advertisements are kept "current", and since the amount of advertisement data is relatively small compared to the size of the game program itself, the amount of "download" time is small in the first discussed embodiment. Of course, the download time of advertisement selection code S in the second discussed embodiment is insubstantial.

In accordance with the present invention, updated or "new" advertisement data is downloaded or a new advertisement selection code is downloaded each time a game program is executed. However, such data need not be downloaded every time the game program is executed, and instead, may be downloaded only on a new day or a new week (or month) on which the game program is executed.

However, this portion of the Ebisawa patent lacks any discussion of the updating of the *position* of the "advertisement data" in the game, and

AMENDMENT ACCOMPANYING A REQUEST FOR CONTINUED EXAMINATION

Appln. No. 09/472,666

Amendment dated March 28, 2005

Reply to: Final Office Action of October 28, 2004

Title: METHOD AND MEDIA FOR VIRTUAL PRODUCT PLACEMENT

therefore it is submitted that this portion of Ebisawa would not lead one of ordinary skill in the art to "update *a position of the virtual product location*" as required in claim 19, or the similar requirements in claims 33, 55, 56, and 66.

In contrast, it is submitted that one of ordinary skill in the art, considering the disclosure of the Ebisawa patent, would be led to "advertisement data A, B, C, and D" that is uniformly positioned in the same location, even as the advertisement data displayed is changed from A to B to C to D, and so forth. Considering Figures 1A and 1B of the Ebisawa patent, it is clear that the position of the advertisement data remains the same and that there is no updating of the position of the location of the advertisement data. The Ebisawa patent only shows the substantiation, in the *same* position, of one advertisement for another advertisement. Similarly and consistently, Figures 2A and 2B show the substitution of "D" for "C" in the video game, but the position is clearly not changed or updated.

It is therefore submitted that not only does the Ebisawa not lead one of ordinary skill in the art to "update *a position of the virtual product location* within the removable moving media", the Ebisawa could only lead one of ordinary skill in the art toward substituting or replacing advertisements in a consistent, unchanging position for its advertising data that is not updated or changed when the advertisement data is changed. It is therefore also submitted that the allegedly obvious combination of Ebisawa and Margulis would not lead one of ordinary skill in the art to the combination of requirements of claims 33, 55, 56, and 66, and in particular the requirements set forth above.

Withdrawal of the rejection of claims 19, 22 through 25, 33 through 39, and 55 through 66 is therefore respectfully requested.

AMENDMENT ACCOMPANYING A REQUEST FOR CONTINUED EXAMINATION

Appln. No. 09/472,666

Amendment dated March 28, 2005

Reply to: Final Office Action of October 28, 2004

Title: METHOD AND MEDIA FOR VIRTUAL PRODUCT PLACEMENT

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.



By

Jeffrey A. Proehl (Reg. No. 35,987)

LEONARD & PROEHL, Prof. L.L.C.

3500 South First Avenue Circle, Suite 250

Sioux Falls, SD 57105-5807

(605)339-2028 FAX (605)336-1931

Date:

